Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte STEFAN J. HALBLANDER

Appeal No. 2002-1716
Application 09/043,574[1]

ON BRIEF

Before HAIRSTON, BARRETT, and SAADAT, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

REMAND

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection of claims 21 and 32-42. Claims 1-20 and 22-31 have been canceled. Because appellant raises new arguments in the reply brief (Paper No. 27), to which the examiner has not had an

[1] Application for patent filed March 26, 1998, entitled "Method for the Situation-Dependent Arrangement and/or Activation of Resources," which is a national stage application under 35 U.S.C. § 371 of PCT Application PCT/EP96/04212, filed September 26, 1996.

opportunity to respond, we remand for a supplemental examiner's answer pursuant to 37 CFR § 1.193(b)(1) (2000) or for such other action as the examiner may deem appropriate.

DISCUSSION

Claims 21 and 32-42 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Parad, U.S. Patent 5,369,570. Appellant's arguments in the appeal brief are limited to arguing that Parad does not recalculate an optimized schedule in response to error conditions, i.e., it does not perform an ongoing optimization simulation, but responds to changing conditions as best it can (e.g., Brief, Paper No. 25, p. 5). The arguments during prosecution were also limited to the ongoing optimization feature; see request for reconsideration (Paper No. 21) filed in response to the final rejection (Paper No. 18). The examiner addresses the ongoing optimization arguments in the examiner's answer (Paper No. 26).

Now, in the reply brief, appellant, through different counsel at the same firm, argues essentially all of the limitations of claims 21, 32, and 33 summarized in the examiner's statement of the rejection (answer, p. 4). These new arguments were not raised in response to a new point of argument by the examiner; the examiner's statement of the rejection in the final rejection was repeated in the examiner's answer and the examiner's response to the arguments was limited to the ongoing

optimization argument. Under the old Patent and Trademark Office rules, new arguments presented for the first time in the reply brief were untimely and would not be considered. See 37 CFR § 1.193(b) (1996) ("The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer .... The new points of argument shall be specifically identified in the reply brief."). Cf. Kaufman Company, Inc. v. Lantech, Inc., 807 F.2d 970, 973 n.*, 1 USPQ2d 1202, 1204 n.* (Fed. Cir. 1986); McBride v. Merrell Dow and Pharmaceuticals, Inc., 800 F.2d 1208, 1210-11 (D.C. Cir. 1986) ("We generally will not entertain arguments omitted from an appellant's opening brief and raised initially in his reply brief. . . . Considering an argument advanced for the first time in a reply brief, then, is not only unfair to an appellee, . . . but also entails the risk of an improvident or ill-advised opinion on the legal issues tendered."). However, the rules were amended in 1997 to remove this restriction and also to say that a supplemental examiner's answer is not permitted unless remanded by the Board for this purpose. See 37 CFR § 1.193(b)(1) (1999). Thus, by rule, appellant's arguments are not forbidden[2] and the

[2] Appellant's arguments are directed to claims 21, 32, and 33, which were argued in the main brief. We do not think the new rule would permit appellant to argue claims which were never argued in the main brief or to retract statements. Appellant is bound by the arguments of the attorney in the main brief. See Link v. Wabash R.R. Co., 370 U.S. 626, 633-34 (1962) ("Petitioner voluntarily chose this attorney as his representative in the

examiner did not have an opportunity to answer the arguments (although the examiner could have reopened prosecution).

We have examined the portions of Parad cited by the examiner in the statement of the rejection (answer, p. 4), as well as the rest of Parad, trying to decide the case without the need for a remand. However, the correspondence between the claim limitations and the teachings in Parad is not clear, nor are the answers to appellant's new arguments. Accordingly, we remand the application to the examiner under 37 CFR § 1.193(b)(1) for a supplemental examiner's answer or for such other action as the examiner may deem appropriate, such as reopening of prosecution. The rules do not permit an appellant to reply to the supplemental examiner's answer.

In the supplemental examiner's answer, the examiner should point out with particularity how the limitations in claims 21, 32, and 33 correspond to the teachings in Parad, including any claim interpretations or terminology differences that may be relevant to the rejection. For example, is the "event" in claim 21 the same as the "event" in Parad or is it something different as argued by appellant (reply brief, pp. 1-2). If the "event" in claim 21 reads on something different, e.g., the "messages" or "notices" (col. 28, lines 38-63), then this should

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action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent.").

be pointed out. Similarly, the supplemental examiner's answer should point out where Parad describes the "priority" and "criterion" of claims 21, 32, and 33, and should address all the other limitations argued in the reply brief.

A time period of two months is given to the examiner to enter a supplemental examiner's answer or for such other action as the examiner may deem appropriate. If the examiner enters a supplemental examiner's answer, the application should be immediately forwarded to the Board after it is mailed. Appellant may not respond to the supplemental answer.

REMANDED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
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LEE E. BARRETT) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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